IV. REMARKS

RESPONSE TO OBJECTIONS

37 C.F.R. § 1.84(p)(5)

- **The Examiner's Position:**

The Examiner has objected to the drawings as failing to comply with 37 C.F.R. § 1.84(p)(5) because they include the reference sign **624** which is not mentioned in the description (page 2 of the Office Action). The Examiner has suggested that the drawing be corrected or in the alternative that an amendment to the specification be made that addresses reference sign **624** (page 2 of the Office Action).

The Examiner has also objected to claims 21 and 40 as being dependent on a rejected base claim. The Examiner has asserted that the claims would be allowable "if rewritten in independent form including all of the limitations of the base claim and any intervening claim" (page 8 of the Office Action).

- **Applicants' Response:**

Applicants respectfully traverses the Examiner's objection on the basis that the meaning of reference sign **624** would be clear to one of ordinary skill in the art in light of the drawings, *e.g.*, *Fig. 6*.

While traversing the objection, Applicant has amended the specification as set forth above, to indicate that "At step 625, a query is made as to whether the motion picture content displayed is for the display period." Support for such amendment to the specification is found, among other places, at *Fig. 6* wherein the step is depicted as such. In light of such amendment to the specification, Applicants respectfully request that the Examiner's objection with respect to the drawings be withdrawn.

Applicant also respectfully traverses the Examiner's objection to claims 21 and 40 arguing that the claims from which they depend are independently patentable as not disclosed, made obvious by, or suggested by the prior art of record. However, in order to expedite prosecution in this case, Applicants have amended claims 21 and 40 to rewrite them in independent form including all of the limitations of the base claim and intervening claims.

RESPONSE TO REJECTIONS

35 U.S.C. §102(e)

- **The Examiner's Position:**

The Examiner has rejected claims 1 – 3, 9 – 12, 17 – 19, 22 – 30, 32, 37 – 38, 41 – 47, 52 – 53 and 59- 62 under 35 U.S.C.§102(e) as being anticipated by U.S. Patent No. 6,057,872 to Candelore, entitled "Digital Coupons for Pay Televisions" (Candelore '872).

The Examiner asserts that Candelore '872 discloses transmitting motion picture content over a data network to a content display device and a reward engine which provides a award to a viewer upon receipt of display verification data verifying that the motion picture content has been displayed by the content display device for the display period (page 2 – 3 of the Office Action). The Examiner alleges that the Candelore '872 reference includes every element of each independent (1, 25, 44, 52, 59, 60, 61, and 62) and each dependent claim, including disclosing "a content storage device, the content storage device containing the motion picture content (Column 7, Lines 23-27)," "providing a motion picture advertisement (Column 6, Lines 51-55)" as the motion picture content of the Candelore invention, "displaying the motion picture content for the display period," identification of "the content display device displaying the motion picture content" to the "reward engine" and the motion picture content being "based on a demographic of the viewer (Column 17, Lines 65 – 67 and Lines 1 – 2)" (pages 3 – 4 of the Office Action).

- **Applicants' Response:**

Applicants respectfully traverse the Examiner's 35 U.S.C. §102(e) rejections asserting in part that the references of record do not teach every element of any claim. Applicants respectfully note that anticipation requires that each and every element of the claimed invention be disclosed in the prior art reference, device, or practice (See, *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

As Applicants have amended their claims herein to streamline prosecution of the claims to embodiments of the invention which are currently believed to be of commercial interest, Applicants comments will be directed to the new pending claims.

Applicants fundamentally disagree with the Examiner that the Candelore '872 reference teaches providing motion picture content "based on a demographic of the viewer (Column 17, Lines 65 – 67 and Lines 1 – 2)" or the "content display device request[ing] the motion picture content based on a viewing habit of the viewer" (pages 3 – 6 of the Office Action). Rather a careful read of the reference finds that references to "demographics" relate to sending "digital coupon information" based upon information relating to pre-garnered demographic information or demographic information that is supplied by the user(s) of a terminal:

> "The controller can thus deliver different digital coupon information to the different subscriber terminals based on the usage pattern data or other demographic or individual data which has been compiled by other means." Col. 4, ln. 26 - 29
>
> "[T]he digital coupon information may be targeted to individual terminals and/or to groups of terminals, for example, according to demographic data." Col. 5. ln. 49 – 53
>
> "Again, different terminals may receive different coupon data according to demographic factors and the like." Col. 11, ln. 60 – 61.

> "Additionally, with an optional report back feature, terminal usage pattern data can be retrieved and analyzed to determine the effectiveness of the promotions and to gather additional demographic and individual data." Col. 17, ln. 66 – Col. 18, ln. 2.

"Digital coupons" are described as "credit information" transmitted "to individual subscriber terminals to promote particular programs and reward viewer loyalty" (Col. 3, ln. 2 – 5) wherein "digital coupon information allows the terminals to obtain credits when recovering particular programs as defined by preconditions of the digital coupon information" (Col. 3, ln. 29 – 31). Thus, the Candelore '872 reference does not teach or suggest transmitting programs (as opposed to "digital coupon information") based on demographics, and certainly does not suggest sending programs based upon the actual viewer (rather than some hypothetical viewer based on household usage patterns) of the material.

The Applicants further respectfully disagree with the Examiner that the Candelore '872 reference equates an advertisement with a "program" or "program service" (page 3 of the Office Action):

> The program service may include television programs which are broadcast or continuously transmitted on a predetermined schedule, pay-per-view programs which require specific user selection and either a local transacted or remotely transacted purchase, Near Video-On-Demand which is pay-per-view offered at staggered broadcast times, and Video-On-Demand services, which are transmitted only in response to a user request, or other electronic information such as computer software. Col 3, ln. 9 – 17.
>
> The program services can be selectively recovered by the subscriber terminals. For example, a subscriber may select a particular program to view by tuning in the corresponding channel using an on-screen interface. Col. 3, ln. 19 – 23.

> The credits are usable in obtaining program services at a reduced charge (e.g., at a discount or free). Col. 3, ln. 37 – 39.
>
> A method and apparatus are presented for allowing users of program services such as pay television to obtain credits when viewing particular programs. Col. 4, lines 63 – 65.

The particular statement used by the Examiner to assert that the Candelore '872 reference discloses providing an award for watching an advertisement simply does not indicate the same but only indicates that the usage pattern in regard programs or program services retrieved might be found useful by advertisers in targeting the advertisements:

> Such usage pattern data provides valuable information for program service providers and advertisers which can be used to better target individual subscribers and groups of subscribers with products and services with which they are likely to be interested. Col. 6, lines 51 – 55.

Applicants respectfully assert that as each independent claim (and therefore each claim depending from such independent claims) recite that either that the content display device receives information pertaining to the actual individual requesting the motion picture content or watching the motion picture content, or that the motion picture content comprises an advertisement wherein the award is given for watching the advertisement, that each of the claims is clearly not anticipated by, nor made obvious in light of, the Candelore '872 reference. Therefore, Applicants respectfully request that such 35 U.S.C. §102(e) rejections be withdrawn, and the claims be found allowable.

35 U.S.C. §103(a)

- **The Examiner's Position:**

The Examiner has rejected claims 4- 8, 13 – 16, 20, 31, 33 – 36, 39, 48 – 51, and 54 – 58 under 35 U.S.C. §103(a). The Examiner rejects each of the claims over the Candelore '872 reference in view of "Official Notice" of asserted "obvious" modifications thereof.

The Examiner specifically states that respect to claims 4 – 8 and 54 – 58 that it "would have been obvious to provide the user with a sporting event, situation comedy, drama series, news event, or miniseries" (page 6 – 7 of the Office Action). In regard to claims 13 – 16, and claims 33 – 36 and 48 – 51, the Examiner asserts that "it would have been obvious to provide a computer monitor, PDA, cellular phone or liquid crystal display for the purpose of providing a cost effective or portable solution for displaying motion picture content" (page 7 of the Office Action). In regard to claims 20 and 39, the Examiner acknowledges that the Candelore '872 reference "fails to teach using th[e] report back data to enter the user in a sweepstakes" (page 7 of the Office Action). However, the Examiner asserts that "it would have been obvious to enter a user in a sweepstakes using this report back data for the purpose of providing vendors with more detailed information and allowing the users the opportunity to win prizes" (page 7 of the Office Action).

- **Applicants' Response:**

Applicants respectfully traverse the Examiner's 35 U.S.C. §103(a) rejection based in part upon the argument that the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Applicant notes that each of the claims that has been rejected by the Examiner under 35 U.S.C. §103(a) are dependent claims that depend on independent claims discussed above with respect to the Examiner's 35 U.S.C. §102(e) rejection. As each of these independent claims are asserted to be patentable for at least the reasons discussed above, Applicants respectfully assert that each of the dependent claims, which claim something less than the independent claims, also assert patentable subject matter.

RESPONSE TO ALLOWABLE SUBJECT MATTER

- **The Examiner's Position:**

The Examiner has allowed 21 and 40 "if rewritten in independent form including all of the limitations of the base claim and any intervening claim."

- **Applicants' Response:**

As set forth above, Applicants respectfully traverse the objection to claims 21 and 40 arguing that the claims from which the depend are independently patentable. However, as further set forth above, Applicants have amended claims 21 and 40 to be in independent form to include all of the limitations of the base claim and any intervening claim. It is therefore asserted that the claims are in condition of allowance.

NEW ART OF RECORD NOT RELIED UPON

The Examiner has made of record, but not relied upon, U.S. Patent No. 6,237,145 to Narasimhan *et al.* which the Examiner asserts discloses a system for accessing promotion information and generating redeemable coupons. Applicants have reviewed such reference and do not believe that such reference impacts the patentability of the claims as presently pending for all of the reasons set forth above.

CONCLUSIONS

An early notice of allowance in the next office is earnestly requested.

Respectfully Submitted,

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Steven J. Moore, Reg. No. 35,959
Attorneys for Applicants
Pillsbury Winthrop
695 East Main Street, Suite A-3
Stamford, CT 06901
Tel.: 203-965-8254
Fax: (203) 965-8226
E-mail: steven.moore@pillsburywinthrop.com